PATENT

Atty Docket No.: 200315473-1
App. Ser. No.: 10/697,974

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the claim amendments and following remarks.

By virtue of the amendments above, Claims 1-4, 6, 9, 11-15, 18-21, 23, 26, 27, 32, 39, 40, 42, 45, and 46 have been amended and Claims 5, 36, and 37 have been canceled without prejudice or disclaimer of the subject matter contained therein. Accordingly, Claims 1-4, 6-35, and 37-46 are pending in the present application, of which Claims 1, 18, 32, and 39 are independent.

No new matter has been introduced by way of the claim amendments; entry thereof is therefore respectfully requested.

Allowable Subject Matter

The indication that Claims 3-5, 24-27, 37, and 43-46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form is noted with appreciation. As noted above, Independent Claim 1 has been amended in various respects, including, the addition of the features contained in allowable Claim 5. Independent Claim 18 has also been amended to include the features of allowable Claim 26, and independent Claim 32 has been amended to include the features of allowable Claim 37. Moreover, Independent Claim 39 has been amended to include the features of allowable Claim 45.

For at least the foregoing reasons, it is respectfully submitted that independent Claims 1, 18, 32, and 39 and the claims that depend therefrom are allowable over the cited documents of record.

Drawings

The Official Action fails to indicate whether the drawings submitted on October 31, 2003 have been accepted. The drawings are considered to be acceptable, however, because the Official Action has not set forth any particular objections to the drawings.

Information Disclosure Statement

The indication that the documents cited in the Information Disclosure Statements submitted on October 31, 2003, November 26, 2004, and May 9, 2005 have been considered is noted with appreciation.

Claim Rejection Under 35 U.S.C. §112

The Official Action sets forth a rejection of Claim 10 as allegedly being indefinite. More particularly, the Official Action asserts that there is insufficient antecedent basis for "the material" in line 1. The Official Action additionally asserts that Claim 10 is indefinite because it is allegedly unclear as to whether the "material" refers to "the ink material or another different material."

These rejections are respectfully traversed because "the material" recited in Claim 10 clearly refers to the material originally recited in Claim 1, to which Claim 10 depends. As such, "the material" clearly refers to the material contained in the reservoir that is configured to be delivered onto the substrate, as recited in Claim 1. Accordingly, "the material" has antecedent basis and refers to the material to be delivered from the jetting assembly.

The Examiner is therefore respectfully requested to withdraw the rejection of Claim 10.

In addition, the reference to "the material" as comprising "the ink material" in the Official Action is improper because none of the claims refers to "the material" as "the ink material". Instead, "the material" may comprise any of the materials listed in Claim 10.

Claim Rejection Under 35 U.S.C. §102

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

> Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

The Official Action sets forth a rejection of Claims 1, 2, 6-8, 11, 13-23, 28, 29, 32, 33, 35, 36, and 39-42 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 4,620,198 to Behun. For at least the reasons set forth below, Behun fails to teach or suggest all of the features of at least independent Claims 1, 18, 32, and 39.

The Official Action has indicated that Behun fails to disclose "an electrostatic potential delivery device for delivering electrostatic potential to [a] support plate, wherein

delivery of electrostatic potential to the support plate operates to vary the velocities at which the droplets impact the substrate." This feature, which as originally claimed in Claim 5, has been added to independent Claim 1. As such, Behun cannot anticipate Claim 1 of the present invention.

In addition, the Official Action has indicated that Behun fails to disclose the features of original Claims 26, 37, and 45. These features have respectively been added to independent Claims 18, 32, and 39. As such, Behun cannot anticipate Claims 18, 32, and 39 of the present invention.

Accordingly, the Examiner is respectfully requested to withdraw the rejection of Claims 1, 18, 32, and 39 and the claims that depend therefrom and to allow these claims.

Claim Rejection Under 35 U.S.C. §103

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claims 9 and 34

The Official Action sets forth a rejection of Claims 9 and 34 under 35 U.S.C. § 103(a) as allegedly being unpatentable over the disclosure contained in Behun in view of U.S. Patent No. 4,281,332 to Horike. This rejection is respectfully traversed because Behun and Horike, considered singly or in combination, fails to disclose the invention as set forth in independent Claims 1 and 32 of the present invention and the claims that depend therefrom.

As discussed above, Behun fails to disclose the features of independent Claims 1 and 32. In addition, the Official Action relies upon Horike for its alleged disclosure of a heating means and does not assert that Horike makes up for the above-described deficiencies in Behun. Moreover, Horike does not and can not be reasonably construed as making up for the deficiencies of Behun discussed above.

The proposed combination of Behun and Horike, therefore, fails to disclose all of the features in independent Claims 1 and 32 and the claims that depend therefrom. The Examiner is therefore respectfully requested to withdraw the rejection of Claims 9 and 34 and to allow these claims at least by virtue of their dependence upon allowable Claims 1 and 32.

Claim 10

The Official Action sets forth a rejection of Claim 10 under 35 U.S.C. § 103(a) as allegedly being unpatentable over the disclosure contained in Behun in view of U.S. Patent No. 3,916,421 to Hertz. This rejection is respectfully traversed because Behun and Hertz, considered singly or in combination, fails to disclose the invention as set forth in independent Claim 1 of the present invention and the claims that depend therefrom.

As discussed above, Behun fails to disclose the features of independent Claim 1. In addition, the Official Action relies upon Hertz for its alleged disclosure of a "reactant" and does not assert that Hertz makes up for the above-described deficiencies in Behun. Moreover, Hertz does not and can not be reasonably construed as making up for the deficiencies of Behun discussed above.

The proposed combination of Behun and Hertz, therefore, fails to disclose all of the features in independent Claim 1 and the claims that depend therefrom. The Examiner is therefore respectfully requested to withdraw the rejection of Claim 10 and to allow this claim at least by virtue of its dependence upon allowable Claim 1.

Claims 12, 30, 31, 38

The Official Action sets forth a rejection of Claims 12, 30, 31, and 38 under 35 U.S.C. § 103(a) as allegedly being unpatentable over the disclosure contained in Behun in view of U.S. Patent No. 5,481,288 to Keeling et al. This rejection is respectfully traversed because Behun and Keeling et al., considered singly or in combination, fails to disclose the invention as set forth in independent Claims 1, 18, and 32 of the present invention and the claims that depend therefrom.

As discussed above, Behun fails to disclose the features of independent Claims 1, 18, and 32. In addition, the Official Action relies upon Keeling et al. for its alleged disclosure of a separately replaceable reservoir and does not assert that Keeling et al. makes up for the above-described deficiencies in Behun. Moreover, Keeling et al. does not and can not be reasonably construed as making up for the deficiencies of Behun discussed above.

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The proposed combination of Behun and Keeling et al., therefore, fails to disclose all of the features in independent Claims 1, 18, and 32 and the claims that depend therefrom. The Examiner is therefore respectfully requested to withdraw the rejection of Claims 12, 30, 31, and 38 and to allow these claims at least by virtue of their respective dependencies upon allowable Claims 1, 18, and 32.

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Dated: January 5, 2006

By _____
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